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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,257

02/22/2005

Thomas Aue

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RANKIN, HILL & CLARK LLP

38210 Glenn Avenue

WILLOUGHBY, OH 44094-7808

EXAMINER

NIA, ALIREZA

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

06/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/525,257	<b>Applicant(s)</b> AUE, THOMAS	
	<b>Examiner</b> ALIREZA NIA	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |



## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller 5,807,240.**

3. With respect to claim 1, Muller '240 discloses a urological resectoscope 10 comprising a main body 50, a guide 22 of a slide carriage 12 being affixed to and proximally extending from said main body 50 via 28, an inner shaft 32 for feeding fluid via 44,68, and an outer shaft 30,34 for removing fluid via the space 70 between the inner 32 and outer 30,34 shafts, both shafts extending distally from the main body (col. 3, lines 17-37), said outer shaft 30,34 enclosing said inner shaft 32, and an optics 14 traversing the main body 50 and the inner shaft 32 wherein the outer shaft 30,34 is directly connectable to the main body 50 by an externally actuated outer connector element 42,52 (col. 2, lines 18-67, col. 3, lines 1-67, figs. 1a,1b).

4. With respect to claims 2, 4-5, Muller '240 further discloses the inner shaft 32 is affixed to the main body 50 (col. 2, lines 56-57, fig. 1b). Muller '240 further discloses the inner shaft 32 is affixed in a borehole of the main body (fig. 1b). Muller '240 also discloses the inner shaft 32 is affixed to a proximal terminal zone 42 of the outer shaft 30,34 (fig. 1b).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 3, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller 5,807,240 in view of Muller 5,486,155.**

7. Muller '240 discloses the invention as discussed above. However, Muller '240 fails to positively disclose an inner connector element detachably affixing the inner shaft to the main body. Muller '240 also fails to positively disclose an inner connector element that detachably affixes the inner shaft to a proximal terminal zone of the outer shaft. Muller '240 also fails to positively disclose a connector element comprised by the inner shaft, the connector element engaging the outer connector element between the outer shaft and the main body.

8. Muller '150 teaches an inner connector element 58 in an analogous resectoscope, the inner connector element 58 detachably affixing an inner shaft to a main body (fig. 3A). Muller '150 also teaches an inner connector element 64 that detachably affixes an inner shaft 54 to a proximal terminal zone of an outer shaft 50 (fig. 3A). Also, Muller '150 teaches a connector element 62,86 on an inner shaft, the connector element 62,86 engaging an outer connector element 60,96 (figs. 3A,3B), resulting in an improved endoscope having a rotatable connection of an inner sheath with respect to a working element mitigating damage caused to tissue when the device is rotated inside a patient's body (col. 1, lines 21-22 et seq. lines 36-39).

9. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the resectoscope of Muller '240 with the above discussed limitations as taught by Muller '155 in order to have provided an improved endoscope having a rotatable connection of an inner sheath with respect to a working element mitigating damage caused to tissue when the device is rotated inside a patient's body, facilitating better flexibility, maneuverability, and efficiency during complex surgical procedures for a surgeon without the risk of harming critical areas within a cavity of a patient.

***Response to Amendment***

10. The amendment to claim 1 in the response filed on March 12<sup>th</sup>, 2008 is acknowledged.
11. Currently, claims 1-7 are pending in the application.

***Response to Arguments***

12. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALIREZA NIA whose telephone number is (571)270-3076. The examiner can normally be reached on Mo.-Fri.-7:30 AM-5:00 PM EST-Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. N./

Examiner, Art Unit 3739

Alireza Nia

June 24<sup>th</sup>, 2008

/Linda C Dvorak/

Supervisory Patent Examiner, Art Unit 3739